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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,154	07/03/2003	Anna-Carin Elfstrom	018798-171	4120

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EXAMINER

HAND, MELANIE JO

ART UNIT	PAPER NUMBER
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3761

MAIL DATE	DELIVERY MODE
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06/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/612,154

Applicant(s)

ELFSTROM ET AL.

Examiner

Melanie J. Hand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, see Remarks, filed March 23, 2007, with respect to the objection to claim 18 are moot in view of the amendment to claim 18.

Applicant's arguments, see Remarks, with respect to the rejection of claim 20 under 35 U.S.C. 112 have been fully considered and are persuasive. The rejection of claim 20 under 35 U.S.C. 112 has been withdrawn.

Applicant's arguments filed March 23, 2007 have been fully considered but they are not persuasive.

With respect to applicant's arguments titled "Lack of Completeness of Office action": It is unclear what basis applicant has for the statement that Examiner did not address the limitation regarding sealing of the liquid-tight and liquid-permeable layers beyond the absorbent layer.

Applicant is referred back to the Office action mailed November 30, 2006, page 3, where the following is explicitly stated:

"Rooyakkers teaches an absorbent product for men, comprising a front section indicated generally at 180, a rear section indicated generally at 176, and a crotch section 118 between the front and rear sections, an absorption body 194 which tapers towards one end from a front section of the product towards the crotch section of the product and which is enclosed in a sheath comprising a liquid-tight layer 196 on a side of the absorption body facing away from the user during use and a liquid-permeable layer 192 on an opposite side of the absorption body, both of which layers extend beyond the absorption body and are mutually joined together..." (emphasis added)

This constitutes the full extent of examiner's response to this argument.

With respect to applicant's arguments titled "Art Rejections": In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

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USPQ 375 (Fed. Cir. 1986). If one were to look at Figs. 1 and 4 of Li closely, one can easily see that, were the device to be placed in the exact same position on a male, the strip would in fact be located in a narrow end of the absorbent body of the combined teaching of Rooyakkers and Li. Such use of the device of Li on a human male would not destroy the function of the barrier, as it would still be fully capable of preventing leakage.

In response to applicant's argument that Li is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Examiner disagrees completely that Li is not analogous art. The fact that Li teaches a female urinal device is immaterial. The device of the claimed invention, while intended for use by a male, is perfectly capable of collecting urine from a human female as well. Similarly the device of Li can also be used to collect urine from a human male.

Examiner is interpreting applicant's comment regarding a "shopping list" as intending to assert that examiner has used impermissible hindsight. Therefore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments regarding the prior art of Wilson are based upon applicant's arguments regarding the perceived deficiencies of Rooyakkers and Li, which have been addressed *supra*.

It is noted that applicant did not formally address the objection to claim 24, however the exemplary language does not appear in claim 24. The objection to claim is withdrawn

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6-14, 16-20, 23-28 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyakers (U.S. Patent No. 4,675,012) in view of Li (U.S. Patent No. 4,023,216).

With respect to **claims 1,26,34**: Rooyakkers teaches an absorbent product for men, comprising a front section indicated generally at 180, a rear section indicated generally at 176, and a crotch section 118 between the front and rear sections, an absorption body 194 which tapers towards one end from a front section of the product towards the crotch section of the product and which is enclosed in a sheath comprising a liquid-tight layer 196 on a side of the absorption body facing away from the user during use and a liquid-permeable layer 192 on an opposite side of the absorption body, both of which layers extend beyond the absorption body and are mutually joined together, and the absorption body 194 is arranged to extend, during product usage, from the front section of the product in the direction of the crotch section 118 and is adapted to extend with its narrower end section to slightly below the penis of the user as seen in Fig. 7.

Rooyakkers does not teach a liquid barrier applied on the liquid-permeable layer 192 at the narrower end section of the absorption body. Li teaches a portable urinal that contains a liquid-permeable absorbent material 18 disposed on the innermost surface of said urinal. Li teaches that the permeable material is arranged to prevent urine emitted by the user from leaking from the surface of the absorption body (Col. 3, lines 35-40), therefore it would be obvious to one of ordinary skill in the art to place a liquid permeable barrier adjacent the innermost layer of the device of Rooyakkers to prevent urine leakage as taught by Li.

With respect to **claims 2,27**: The absorbent product 40 taught by Rooyakkers is an insert adapted for use with underpants 44 and the absorbent product is provided with one or more fastening members in the form of adhesive strips on an outer side of the liquid-tight layer, which fastening members are adapted to hold the absorbent product 40 in place inside the underpants 44. (Col. 6, lines 54-61)

With respect to **claim 3**: The product taught by Rooyakkers as a whole has a pants shape, the front section and the rear section being adapted to surround a waist of the user. Rooyakkes teaches a typical male brief for underpants 44, wherein a typical male brief has a front or rear section is provided with waist elastic which is adapted to hold the absorbent product in place on the user.

With respect to **claim 6**: The liquid barrier taught by Li is arranged to follow the contour of the lower, narrower end section of the absorption body and is applied in its entirety inside the said contour.

With respect to **claim 7**: The combined teaching of Rooyakkers and Li teaches a liquid barrier that crosses the absorption body close to its narrower end and the liquid barrier is convex in the direction of the said end, as it follows the contour of the absorption body at said narrower end, which is convex.

With respect to **claim 8**: The liquid barrier of the combined teaching of Rooyakkers and Li extends in the lateral direction beyond the absorption body and in the transverse direction spans the whole of the absorbent product taught by Rooyakkers.

With respect to **claims 9-11**: Rooyakkers teaches a volume for device 40 of 275-400 cm³ and an equilateral triangle-shaped opening that is 10 cm on each side, therefore the depth of said pouch is between 12-18 inches. (Col. 6, lines 26-33) Rooyakkers teaches a desirable cross-sectional area for a point 5-6.5 cm down the back wall to ensure that the slope is not too severe as to limit proper placement of the penis of the user (Col. 6, lines 46,47), therefore Examiner is considering the portion that is between 6.5 cm down the back wall and the bottom as the effective absorbent end portion that is substantially identical to the claimed invention and thus the height of the effective absorbent end portion has a height in the range of 65 - 180 mm, thus satisfying the relevant limitations of claims 9-11.

With respect to **claim 12**: The liquid barrier taught by Li is a separate deformable pad and is thus capable of being fixed in the rest of the absorbent product only along its outer edge section and inner-situated sections. Such outer edge section and inner-situated sections of the liquid barrier are capable of being arranged to be raised from the liquid-permeable layer during product usage simply by folding the absorbent barrier taught by Li and placing said barrier in the

crotch portion of the device of Rooyakkers.

With respect to **claim 13**: The liquid barrier taught by Li is constituted by a roll formed from one or more band-shaped materials, which roll is capable of being bent into a convex shape in the direction of the narrower end of the absorption body.

With respect to **claim 14**: Li does not teach that the absorbent liquid barrier is constituted by a number of circumferential folds, however the material of the barrier is foldable, and in order for the barrier to carry out its proper function of collecting excess urine from a user's penis, it would be obvious to one of ordinary skill in the art to perform a number of circumferential folds of the one or more band-shaped materials defining the barrier taught by Li with a reasonable expectation of success, which liquid barrier, following the formation of the folds, is elongated in the direction of the fold lines forming the folds, and the liquid barrier is folded or bent into shape.

With respect to **claim 15**: Rooyakkers teaches, as can best be seen from Fig. 12, that the resulting said narrow end portion has a "V" shape. Rooyakkers does not teach a barrier. Li teaches a barrier but does not teach folding the barrier in the manner set forth in claim 15, however it has been established herein that the barrier is capable of being folded in such a manner as to fit in the crotch section of the device of Rooyakkers and that it would be obvious to one of ordinary skill in the art to do so.

With respect to **claim 16**: As can best be seen in Fig. 15, Rooyakkers teaches a "U-shaped" narrow end, where the base of the "U" resides in the crotch section when worn with an undergarment. Rooyakkers does not teach a barrier. Li teaches a barrier but does not teach

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folding the barrier in the manner set forth in claim 15, however it has been established herein that the barrier is capable of being folded in such a manner as to fit in the crotch section of the device of Rooyakkers and that it would be obvious to one of ordinary skill in the art to do so.

With respect to **claim 17**: Rooyakers does not teach a particular folding angle for the U-shaped narrow end. As seen in Figs. 9 and 13-15, the angle is clearly less than 90 degrees. Applicant does not set forth a criticality for the measurement of the angle that encompasses the alternate teaching of a "V-shaped" barrier, therefore Examiner is considering the limitation that the angle be exactly 45 degrees or less than 45 degrees to be optimizations of the angle measurement and are therefore unpatentable over the prior art of the combined teaching of Rooyakkers and Li. It has been held that where general conditions of claim are disclosed in prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. See *In re Aller*, Lacey and Hall (105 USPQ 233, CCPA, 1955). It would be obvious to one of ordinary skill in the art to vary the folding angle to be equal to or less than 45 degrees so as to achieve different varieties of a U-shaped barrier, as any U-shaped barrier would ensure proper support and function of the device of Rooyakkers.

With respect to **claims 18,36**: Li teaches that the band-shaped material for the liquid barrier consists of non-woven material. ('216, Col. 3, lines 35-40)

With respect to **claim 19**: The liquid barrier taught by Li is constituted by a single material strip 18 that has been folded or bent into suitable shape before being applied. ('216, Col. 3, lines 13-15)

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With respect to **claim 20**: The single material strip 18 taught by Li is a non-woven material, but Li teaches cotton for the strip material, which is not hydrophobic. However, in light of the rejection of claim 20 under 35 U.S.C. 112, claim 20 is considered herein to be unpatentable over the combined teaching of Rooyakkers and Li.

With respect to **claims 21,22**: Li does not teach that the barrier is provided with a pretensioned elastic element, specifically a thread, to hold said barrier in a raised state. Rather, Li teaches that the barrier is molded by steam and pressure into the desired shape, which includes a raised shape. The steam and pressure molding is considered herein to be an alternate means to providing pretensioned elastic threads for retaining said barrier in the raised state, and thus it would be obvious to one of ordinary skill in the art to use pretensioned elastic elements to retain the barrier of Li in the raised shape, rather than molding, with a reasonable expectation of success.

With respect to **claim 23**: The liquid barrier of Li is molded into its desired shape and thus has an inherent stiffness of such magnitude that the liquid barrier applied in the folded or bent state, by virtue of its own inherent stiffness in the bent or folded state during product usage, is held with its free longitudinal edge section in the raised state.

With respect to **Claim 24**: Rooyakkers teaches that the absorption body 192 is comprised of cellulose fluff pulp fibers with highly absorbent superabsorbent gel material mixed in. (Col. 6, lines 1-3) The liquid barrier taught by Li is constituted by a molding formed from airlaid cotton linter fibers. It has been established herein that the barrier taught by Li is capable of being folded in such a manner as to follow the contour of the narrower end section of the absorption

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body taught by Rooyakkers, on or directly outside of same, and that it would be obvious to one of ordinary skill in the art to do so.

With respect to **claim 25**: Li teaches that the liquid barrier is cast into the desired shape but does not teach a foam material. Since foam material is also a hydrophilic absorbent material capable of being cast into its desired shape, it would be obvious to one of ordinary skill in the art to substitute foam for the cotton material taught by Li since both provide a more desired softer feel on the skin of a user.

With respect to **claim 35**: Li teaches a liquid barrier that is a separate piece that can be inserted between the liquid-tight layer and the liquid-permeable layer taught by Rooyakkers. It would be obvious to one of ordinary skill in the art to place the absorbent barrier taught by Li between the liquid-tight layer and the liquid-permeable layer as placing the barrier material in that position provides additional leakage protection.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyakers (U.S. Patent No. 4,675,012) in view of Li (U.S. Patent No. 4,023,216) as applied to claims 1, 2, 6-14, 16-20, 23-28, 34 and 35 above, and further in view of Wilson et al (U.S. Patent No. 6,023,789).

With respect to **claim 4**: Rooyakkers does not explicitly teach the placement of an elastic member in underpants 44. Wilson teaches sports short 10 made of Lycra® ('789, Col. 4, lines 19-21) material having a genital protector comprising at least one elastic waistband in a front section. Wilson teaches that said elastic waistbands allow accommodation of a variety of waist

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sizes ('789, Col. 3, lines 8-10), therefore it would be obvious to one of ordinary skill in the art to modify the briefs taught by Rooyakkers to contain at least one elastic waistband in a front section as taught by Wilson. With respect to claim 4, Wilson also teaches that the body portion of the shorts, including the crotch portion, is formed from elastic material ('789, Col. 4, lines 19-21) that is capable of being pulled down and subsequently returned to an initial position against the wearer via said elastic waistband and elastic material. Wilson teaches that the elastic material applies a compressive force for added protection and moisture wicking ('789, Col. 3, lines 1-5), therefore it would be obvious to one of ordinary skill in the art to modify the underpants taught by Rooyakkers to be comprised of elastic material that is not only tight fitting (as taught by Rooyakkers) but able to be pulled and deformed for easy removal as taught by Wilson.

With respect to **claim 5**: Wilson teaches that the waist elastic 12 is formed from an elastic first piece, collectively 14,16, which, in the extended state, is essentially rectangular and which is adapted to partially surround the trunk of the user and form the rear section and side sections of the pants product, a second piece 26, incorporated in the product, is configured to form the front section and crotch section of the pants product, the second piece is elongated with two opposing end edges and two opposing longitudinal edges, the width of the second piece, at least at the crotch section, is less than the length of the first piece, the second piece with its longitudinal direction is arranged perpendicularly to the longitudinal direction of the first piece and is connected by a first end section to the one longitudinal edge section of the first piece and centrally on this, the one end section of the first piece is connected to a first side edge section of the second piece, and the second end section of the first piece (14,16) is correspondingly connected to a second side edge section of the second piece 26, and the absorption body

applied, in its entirety, on the second piece.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie J Hand
Examiner
Art Unit 3761

June 1, 2007

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

